

Application No. 10/634,492  
Amendment Dated May 1, 2005  
Reply to Office Action of January 3, 2005

**REMARKS/ARGUMENTS**

Reconsideration of the above-identified application is respectfully requested in view of the foregoing amendments and the following remarks. In accordance with Examiner Meislin's recommendations to incorporate limitations recited in the specifications into the claims, claims 1 - 6 have been amended and remain in the case.

Claim 1 has been amended to better define the non-adjustable nature of this embodiment, "of predetermined size for fitting only one size bolt or nut", to clarify the attachment of the ends of the two socket elements by insertion of pins through provided holes, and to distinguish the invention over references of record. These changes make clear the structure of the current invention, based on material in the original specification. No new matter has been added.

Similarly, claim 4 has been amended to clarify the attachment of the ends of the two socket elements by insertion of pins through provided holes. These changes make clear the structure of the current invention, based on material in the original specification. No new matter has been added.

Claims 2 - 3 and 5 - 6 have been amended to be consistent with the changes made to claims 1 and 4.

Support for the inclusion of the term "of predetermined size for fitting only one size bolt or nut" in claim 1 is found in the specification page 2, lines 16-17, and page 3, lines 1-3.

Support for the inclusion of the term "wherein each of said distal and proximal ends contains a hole therethrough" in claim 1 is found in the specification page 4, lines 2-6.

Support for the inclusion of the term "by means of a pin inserted in said hole" in claim 1 and claim 4 is found in the specification page 4, lines 2-6.

Support for the inclusion of the term "wherein at least one of said pins are removable to allow box wrench disassembly and attachment" in claim 1 is found in the specification page 4, lines 2-6.

Support for the inclusion of the term "wherein said distal end is an elongated arm containing multiple holes therethrough" in claim 4 is found in the specification page 4, lines 11-13.

Support for the inclusion of the term "expandable and contractable" in claim 5 is found in the original claim, claim 4.

This invention is a box wrench with a hinged socket that can fully encompass a bolt, nut, or a threaded connector. A first embodiment is a non-adjustable wrench of a given size and fitting only one size bolt or nut. The distal and proximal ends of each of the socket elements are pinned together in a configuration of specific size, and can be placed around a bolt, nut, or threaded connector, even in a case where mechanism is present on either side of the bolt, nut, or threaded connector, that prevents application of a typical socket tool. In addition, this embodiment, after being pinned in place for use, is not susceptible to falling off the item to be turned. In the second embodiment, the wrench is adjustable, with multiple holes in an elongate arm, providing adjustment to a variety of sizes, and as in the first embodiment, has each of the socket elements pinned together, so that the wrench is not susceptible to falling off the item to be turned.

Claims 1 and 2 were rejected under 35 U.S.C. 102(b) as being anticipated by FISHER. FISHER's patent, however, has two hinges, and a catch type closure, that operates by the force of the torque applied by the resistance of the item being turned to force the ratchet teeth 11 against the cross-bar 6. This structure pulls closed when operated in a counter-clockwise direction, viewing Figure 2, and releases when rotated clockwise. This is in distinction to the

different structure of the Applicant's invention, where the Applicant's device as described in claim 1 has at most one hinge, and in addition, the Applicant's invention in both embodiments is pinned together around the member to be turned, allowing use without possibility of falling off the member to be turned. This also permits the Applicant's invention, after pinning in place, to turn either clockwise or counter-clockwise without releasing.

FISHER's device is detachable, by releasing the ratchet teeth 11 from the cross-bar 6, while Applicant's device can be disassembled only by removing one or more pins. This structural difference results in significant differences in function. Applicant's invention requires in both embodiments two socket elements, 15 and 16 in the first embodiment in Figure 1, and 15 and 16' in the second embodiment in Figure 3. FISHER's invention requires three pieces, elements 3, 8, and 10.

With regard to the capability of FISHER for engaging nuts/bolts, the structural differences noted above result in differences in function, such that FISHER cannot apply torque in both clockwise and counter-clockwise directions without removal and re-application after flipping the wrench over, and the torque applied by FISHER cannot be released without the wrench releasing from the nut/bolt, while Applicant's invention once pinned in place, remains in place even with release of applied torque. Examiner Meislin has pointed to *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963), indicating that "If the prior art structure is capable of performing the intended use, then it meets the claim." and further, "In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." As recited above, FISHER is not capable of applying bi-directional torque and performing functionally as Applicant's invention. In addition, Applicant's invention is not a process of making, but does provide a manipulative difference as compared to the prior art of FISHER.

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Since it is believed that FISHER does not anticipate Applicant's invention, and the rejection of claim 1 of the present invention has been overcome, Applicant respectfully traverses the rejection of claims 1, and 2, under 35 U.S.C. §102(b) as being anticipated by FISHER.

Claim 3 was rejected under U.S.C. §103(a) as being unpatentable over FISHER in view of SCULL. In light of the traverse of the rejection of claims 1, and 2, under 35 U.S.C. §102(b) as being anticipated by FISHER, Applicant respectfully traverses the rejection of Claim 3 under U.S.C. §103(a) as being unpatentable over FISHER in view of SCULL. There is simply no teaching, suggestion or motivation for combining the references to arrive at Applicant's invention.

Claims 4-5 were rejected under U.S.C. §103(a) as being unpatentable over FISHER in view of SCOTT. In light of the traverse of the rejection of claims 1, and 2, under 35 U.S.C. §102(b), Applicant respectfully traverses the rejection of Claims 4-5 under U.S.C. §103(a) as being unpatentable over FISHER in view of SCOTT. There is simply no teaching, suggestion or motivation for combining the references to arrive at Applicant's invention.

Claim 6 was rejected under U.S.C. §103(a) as being unpatentable over FISHER in view of SCOTT in further view of SCULL. In light of the traverse of the rejection of claims 1, and 2, under 35 U.S.C. §102(b) as being anticipated by FISHER, Applicant respectfully traverses the rejection of Claim 6 under U.S.C. §103(a) as being unpatentable over FISHER in view of SCOTT in further view of SCULL. There is simply no teaching, suggestion or motivation for combining the references to arrive at Applicant's invention.

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In view of the foregoing amendments and remarks,  
Applicant respectfully requests that claims 1 - 6 be allowed  
and the application be passed to issue.

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P.O. Box 1450  
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On

5/3/05  
(Date of Deposit)

Mark Levy, Reg. No. 29188  
Attorney

(Date)

Respectfully submitted,  
MARK LEVY & Associates PLLC

By:

Mark Levy  
Reg. No. 29,188  
Attorney for Applicant  
Press Building - Suite 902  
19 Chenango Street  
Binghamton, New York 13901  
Telephone: (607) 722-6600